

REMARKS

Applicant has carefully reviewed the Office Action of January 24, 2005, and offers the following remarks to accompany the amendments presented above.

Before addressing the rejections, Applicant provides a brief summary of the invention so that the remarks relating to the references are considered in the proper context. The present invention is designed to provide a portable device that automatically executes on a host computing device. The portable device may have a number of different functions, but two of the presently claimed functions are the clean up function and the ability to control the user's viewing experience. The clean up function that removes all the cookies, clears the cache, deletes preferences, and otherwise makes the user's private information inaccessible to subsequent users of the host computing device. The ability to control the user's viewing experience controls the user's viewing experience when she is browsing the web. In particular, the software is designed to provide predefined content that overlays the content that would otherwise be displayed by the web browser. The content is displayed in the form of a banner that overlays the web browser, similar to an "always on top" function. The content would cover any pop ups, pop unders, banner ads, or the like that the browser would otherwise normally display. It is this second function which was added to the independent claims by way of amendment in the previous response filed October 5, 2004, and which is not shown by the references of record.

Applicant provides new claim 41 which recites that the software adapted to automatically execute on the host computing device in association with a computing session does so independently of a boot state of the host computing device. Support for this amendment can be found in the application on page 15, line 32-page 16, line 5. In that passage, the application describes that when the key 10 is inserted, the host computing device already has preferences in place that may not match those of the user. As these preferences are already in place, the host computing device must already have been booted. Applicant notes that at other places in the specification, the impending start up of the host computing device is never referenced as being a prerequisite to the insertion of the key. No new matter is added. As Applicant has previously canceled several claims, the addition of claim 41 does not necessitate a fee.

Claims 1, 5-7, 9, 11-15, 17, 21-23, 25, 27-29, 33-35, 37, 39, and 40 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Hendrick. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must

show where each and every claim element is located in the combination of references. MPEP § 2143.03.

Independent claims 1, 17, and 29 all recite "wherein the software is further adapted to instruct the host computing device to display predefined content in relation to content displayed by a web browser *such that the predefined content overlays information provided by the web browser. . .*" (emphasis added). The Patent Office admits that Paul does not teach this element but opines that Hendrick teaches the element at Hendrick col. 10, lines 1-9. Applicant respectfully traverses this assertion.

Hendrick, col. 10, lines 1-9 state in full:

A remote online advertising server 82 for serving up banner advertisements to the user's personal computer 84 will read the profile codes from the smart card 80 using the smart card reader 86 and will then serve to the user's computer advertisements that are targeted according to the user's profile. In this way, the user is provided with advertisement information that is specifically directed to the user's profile.

While the passage does indicate that banner advertisements are provided to the user based on the profile 80, there is no teaching or suggestion that the banner advertisements so delivered overlay the information provided by the web browser as recited in the claims. That is, Hendrick teaches that the particular banner advertisements are chosen based on the profile and then is silent about how those banner advertisements are displayed. Since banner advertisements are normally displayed within the browser, it is understood that Hendrick teaches that the banner advertisements are likewise displayed within the browser. In contrast, the claims recite that the content overlays the information provided by the web browser, and thus Applicant's overlay would cover any traditional banner advertisements such as those described in Hendrick.

Since the Patent Office admits that Paul does not teach the overlay function recited in the claims, and Hendrick does not teach the overlay function for the reasons recited above, the combination of the two references cannot teach or suggest the claim element. As the claim element is present in each of the independent claims, the Patent Office has not established obviousness for any of the independent claims. Claims 5-7, 9, 11-15, 21-23, 25, 27, 28, 33-35, 37, 39, and 40 depend from claims 1, 17, and 29, and are allowable at least for the same reasons. Applicant requests withdrawal of the § 103 rejection of claims 1, 5-7, 9, 11-15, 17, 21-23, 25, 27-29, 33-35, 37, 39, and 40 at this time.

Claims 2-4, 18-20, and 30-32 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Hendrick, in further view of Suga et al. (hereinafter "Suga"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

As explained above, Paul and Hendrick do not show all the claim elements for the underlying independent claims 1, 17, and 29. Claims 2-4, 18-20, and 30-32 depend from claims 1, 17, and 29 respectively, and thus include the limitations of claims 1, 17, and 29. The addition of Suga does not cure the deficiencies of Paul and Hendrick. Thus, in combination, Paul, Hendrick, and Suga do not teach or suggest all the claim elements. Since the combination of Paul, Hendrick, and Suga does not teach or suggest all the claim elements, the Patent Office has not established obviousness for these claims. Applicant requests withdrawal of the § 103 rejection of claims 2-4, 18-20, and 30-32 at this time.

Claim 16 was rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Hendrick, in further view of Yee et al. (hereinafter "Yee"). Applicant respectfully traverses. The standard for establishing obviousness is set forth above.

As explained above, Paul and Hendrick do not show all the claim elements for the underlying independent claim 1 from which claim 16 depends. The addition of Yee does not cure this deficiency. Since the combination of Paul, Hendrick, and Yee does not teach or suggest all the claim elements, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness for claim 16, claim 16 is allowable. Applicant requests withdrawal of the § 103 rejection of claim 16 at this time.

New claim 41, as discussed above, recites that the automatic execution is independent of the boot state of the host computing device. In contrast, Paul is directed to the booting of the host computing device. For example at col. 1, lines 61-64, Paul states "a device that would enable a computer to *boot up with the computer configured in accordance with the user system's configuration preferences would be desirable.*" (emphasis added). Likewise, at col. 3, lines 8-12, Paul states "the user may use his/her configuration card 18 in one or more of these audiovisual devices 10 to enable them and to have them *boot up* with the user's configuration preferences." (emphasis added). Also, at col. 3, lines 30-35, Paul states "the processor 24 may have stored boot-up instructions that causes the processor 25 to read on its I/O bus the instructions governing system configuration and to execute the instructions governing system configuration as part of the start up of the system prior to accepting normal/other user input."

Furthermore, at col. 4, lines 9-11 Paul states "the computer instructions relate to booting up the processor and configuring the user environment." This point is re-emphasized at col. 4, line 20-col. 5, line 5 in the section entitled "Rudimentary Control Software".

Applicant has carefully studied Paul and finds no teaching that the software on his configuration card 18 acts at any other time than the boot up of the host computing device. Since claim 41 recites this element, and Paul does not show this element, claim 41 is allowable. Likewise, the other references of record do not teach or suggest this claim element. Thus, in combination, the references do not teach or suggest this element. Since the references in combination do not teach or suggest this element, claim 41 is allowable.

Applicant requests reconsideration of the rejections in light of the amendments and remarks presented herein. The references of record do not teach or suggest that the banners overlay the browser as recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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